

REMARKS

Applicant has carefully reviewed the Office Action mailed on April 30, 2007. This Amendment document is submitted to address and fully overcome the rejections made in the Office Action.

With respect to the formal issues, Applicant cancels claim 8 to address the issue raised by the Examiner. Claim 7 is also cancelled.

On the substantive side, the Examiner rejects claims 1-2, 5-6, and 9 as being “anticipated” under Section 102(b) of the Patent Act by U.S. Patent No. 2,970,526 to Gobalet. In order for such a rejection to be sustained, Gobalet must disclose each and every limitation of the rejected claims with “strict identity.” See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995) (holding that to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

Gobalet teaches a “compression unit” 18 for vertically conveying formed cartons once delivered from an upstream lug conveyor. This unit 18 uses “pressure elements,” such as plates 31, 38, to apply pressure and help cause the adhesive used to seal the boxes to set. A plunger 25 lifts each box vertically above catches 54 adjacent the plates 31, 38. “Each catch is pivoted to a mounting bracket 55 at its lower portion at 56 and its upper portion comprises a hole 57 through which a fixed pin 58 in the bracket 55 extends” (col. 4, ll. 18-21). Hence, the “catches” 54 are capable of pivoting, but remain fixed as the result of the connection to mounting bracket 55 via pin 58.

In making the anticipation rejections based on Gobalet, Applicant respectfully submits that express requirements of claim 1 are disregarded. For instance, the takeaway conveyor of the claim must have lugs that are “selectively movable to an upstanding position for engaging and conveying the carton.” The corresponding structures according to the Examiner are “catches” 54, but these do not “convey” any cartons at all. Instead, the plunger

25 conveys the cartons to the catches 54, which merely hold the cartons.

Moreover, the Examiner does not contend that the catches 54 move to an “upstanding position” for engaging and conveying the carton. Indeed, Figure 12 shows the catches as extending in a generally horizontal fashion for engaging the cartons, rather than one that is “upstanding,” or generally vertical.

Nevertheless, to emphasize the distinction with the Gobalet device, claim 1 is amended to require that the takeaway conveyor is for “conveying” the corresponding lug. The catches 54 of Gobalet remain fixed in place, and thus are not conveyed by any conveyor. Accordingly, withdrawal of the anticipation rejection is in order.

The Examiner further rejects all claims as being directed to “obvious” inventions based on the Gobalet patent in combination with U.S. Patent No. 4,590,745 to Randles. Randles discloses a carton closing machine with bottom-running, fixed lug conveyors 18, 23. No conveyor with lugs selectively movable to a depending or upstanding position for engaging and conveying a carton is disclosed in Randles. Furthermore, Randles discloses no “means for folding” at least one flap while the carton is conveyed by a takeaway conveyor. Rather, “glue wheels” 54 are provided along the chains 23 with lugs 56, and a downstream “elevator” 60 is used to convey the carton for folding the side flaps (col. 3, lines 48-54 of Randles). Accordingly, neither Randles nor Gobalet teach or suggest the limitations of claims 1-9, and a *prima facie* case of obviousness is lacking for this reason. MPEP § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

As for the combination of Gobalet and Randles, the Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the overhead conveyor in the invention of Randles for forwarding the boxes along the path.

No “reason” is provided for combining the features of these references, which both disclose devices that are already capable of “forwarding boxes” along a path. Accordingly, it is

submitted that a *prima facie* case of obviousness is lacking. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007) (holding that in formulating a rejection under 35 U.S.C. 103(a), it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” and further stating that “**a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art . . .**”) (emphasis added); see also Memorandum of May 30, 2007 from Margaret A. Focarino, Deputy Commissioner for Patent Operations (“in formulating a rejection under 35 U.S.C. 5 103(a) based upon a combination of prior art elements, it **remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed . . .**”) (emphasis added).

Rather than leading a skilled artisan to the claimed inventions, Randles and Gobalet actually teach away from them. Applicant’s claimed carton conveyor advantageously allows for the carton to be conveyed with an overhead lug selectively moved into a position for engaging the carton. This avoids the troublesome “fixed lug” approach of Randles, Gobalet, and others. During high speed operations, fixed lugs have an undesirable tendency to deform the flaps, which may be completely avoided by Applicant’s claimed invention.

Furthermore, Applicant couples the advantages of the overhead conveyor having a depending lug with an orthogonal takeaway conveyor having upstanding lugs. This advantageously provides a much smaller footprint while maintaining the desirable high throughput, and without the need for uncontrolled transfer of the carton between two bottom-running, orthogonal conveyors (which, by their very nature, cannot overlap). The overlaying nature of the overhead conveyor 14a or 14b with takeaway conveyor 16b is demonstrated by Applicant’s Figure 12:

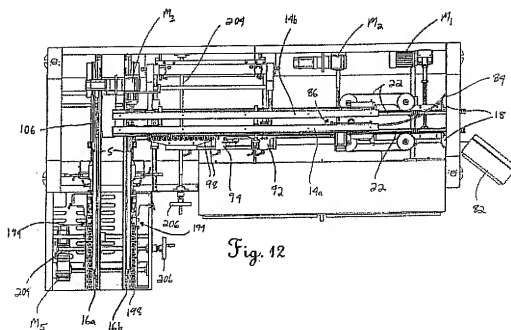


Fig. 12

Neither Gobalet nor Randles even remotely suggest this combination of features, or otherwise provide the concomitant advantages afforded by Applicant's claimed inventions. Instead, Gobalet merely discloses a single lug conveyor, and Randles teaches two bottom-running lug conveyors. These references thus not only represent the *status quo*, but would also actually tend to lead a skilled artisan in a divergent direction from the path taken by the present Applicant. See, e.g. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the applicant."). Accordingly, the cited references are considered inapposite in the obviousness calculus.

With respect to the "final" restriction request, Applicant proposes an amendment to withdrawn claim 10 to make it recite a species of the claim 1 invention, which for the foregoing reasons is believed to be allowable. Claims 16-18 are cancelled. Accordingly,

reconsideration of the decision to withdraw claims 10-15 and 19 is respectfully requested in light of the proposed amendment.

Applicant presents new claims 96-106, which are directed to inventions described in the original specification. Claim 96 is similar to claim 1 in many respects, but requires that the conveying path for the cartons is in the horizontal plane, as well as lugs that move between a retracted and a depending or upstanding position, respectively. This claim further requires a folder for folding the at least one flap while the carton is conveyed along the path by the takeaway conveyor. Claims 97-105 depend from claim 96, and new claim 106 depends from claim 1.

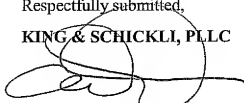
The orthogonal portion of the path in Gobalet is in the vertical, rather than the horizontal plane. Furthermore, there are no retractable lugs arranged as required in claim 96. The same is true of the secondary Randles reference. Neither reference discloses actuators for lugs arranged as required by this claim, either. Accordingly, the allowance of claim 96 and dependent claims 97-106 is believed to be in order.

Finally, Applicant presents a Supplemental Information Disclosure Statement. Reconsideration of the information cited therein is respectfully requested.

In light of the foregoing, Applicant respectfully requests an early Notice of Allowance be issued. Any fees due may be debited from Deposit Account 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the printed name and firm name.

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